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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/784,629

02/23/2004

Joseph P. Errico

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530 7590 12/24/2008
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EXAMINER

WOODALL, NICHOLAS W

ART UNIT

PAPER NUMBER

3775

MAIL DATE

DELIVERY MODE

12/24/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/784,629	Applicant(s) ERRICO ET AL.	
	Examiner Nicholas Woodall	Art Unit 3775	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 17-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>09/08/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to applicant's amendment received on 09/08/2008.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-10, 13, 14, and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keller (U.S. Patent 4,997,432) in view of Davidson (U.S. Patent 4,303,268).

Keller discloses a device comprising an extension, at least two prongs coupled to a fulcrum at the distal end of the extension, and a sleeve (see Figure 1 below), wherein the device manipulates, i.e. inserts, repositions, removes, etc., an implant/prosthesis. The extension includes a longitudinal axis. The two prongs each include semicircular rigid prong extensions including inwardly facing surfaces, wherein the inwardly facing surfaces together define a cylindrical holding enclosure that opens and closes to hold an implant/prosthesis. The first prong is spring-loaded with respect to the second prong to bias the holding enclosure to a receptive state wherein the prongs are separated by a distance that does not allow an implant/prosthesis to pass between the distal ends of the prongs without altering the position of at least one of the prongs, wherein a manual pushing larger than the bias of the prongs in a proximal direction along the longitudinal axis of the extension between the distal ends of the prongs expands the holding

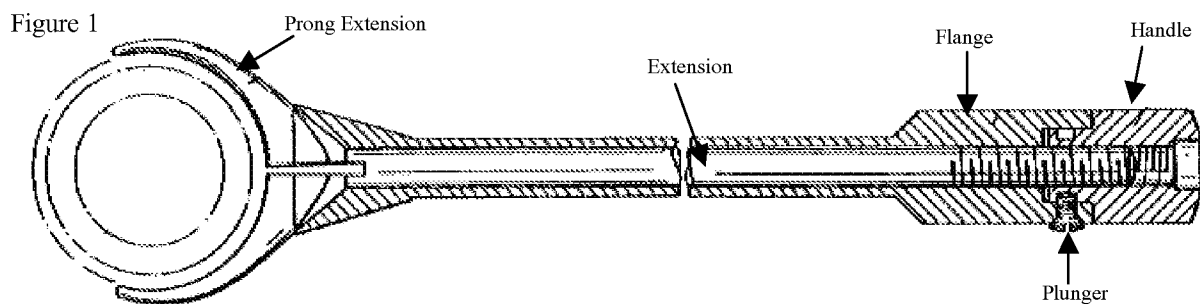
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enclosure such that the prongs are separated by a larger distance that allows an implant/prosthesis to pass between the distal ends of the prongs. The spring-loading of the prongs relative to each other is caused by at least one of a dimension of at least one of the prongs or a material strength of at least one of the prongs. The prong extensions widen outwardly and are tapered more narrowly toward the holding enclosure to facilitate passage of an implant/prosthesis. The sleeve surrounds at least a portion of the distal end of the extension, the fulcrum, and at least a portion of the two prongs. The sleeve is collinear with the longitudinal axis of the extension and is fixed longitudinally by threads that engage the extension to the sleeve, wherein rotation of the sleeve along the threads causes prong extensions to open and close relative to one another. The sleeve includes a bore that extends along the longitudinal axis of the extension, wherein the bore defines a cross-section. Keller discloses a device further comprising a handle having a distal handle end coupled to a proximal end of the extension. Keller discloses a device further comprising a flange that facilitates rotation of the sleeve. Keller fails to disclose the bore of the sleeve further defining a cross-section on a plane perpendicular to the longitudinal axis of the extension, wherein the cross-section has a width greater than a depth. Keller discloses a sleeve, wherein the cross-section of the bore perpendicular to the longitudinal axis of the extension is circular and the bore tapers in order to contract, i.e. close, the prongs of the device. Davidson teaches a device comprising a sleeve including a bore having cross-section perpendicular to the longitudinal axis of extension, wherein the cross-section of the bore includes a width that is greater than a depth for contracting the prongs of the device. Because both

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Keller and Davidson teach a device comprising a sleeve including a bore to contract the prongs of the device, it would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the bore in the sleeve of Keller with the bore in the sleeve of Davidson in order to achieve the predictable results of contracting the prongs of the device.

The device of Keller as modified by Davidson discloses a device wherein the aligning outwardly facing surfaces of the prongs allows the prongs to expand fully without interfering with the inner surfaces of the bore when aligned with the bore width and allow the prongs to contract due to interference with the inner surfaces of the bore when aligned with the bore depth. The device of Keller as modified by Davidson discloses a device wherein the sleeve bore includes at least one corner having a curvature shaped as a radius of the sleeve bore, wherein the outwardly facing surface of at least one of the prongs is curved to match the curvature of the corner to facilitate rotation of the sleeve.



4. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keller (U.S. Patent 4,997,432) in view of Davidson (U.S. Patent 4,303,268) further in view of Myers (U.S. Patent 4,317,387).

The device of Keller as modified by Davidson discloses the invention as claimed except for the plunger being biased from an inner sleeve surface inwardly, wherein the plunger includes a spring. The device of Keller as modified by Davidson discloses a device comprising a positioning mechanism comprising at least one plunger located within a portion of a sleeve wall bore and at least one sleeve wall bore penetrating through the wall of the sleeve in order to position the sleeve relative to the extension. Myers teaches a device comprising a sleeve, an extension, and a positioning mechanism. The positioning mechanism includes at least one plunger located within a portion of a sleeve wall bore, at least one sleeve wall bore penetrating through the sleeve wall, and at least one recess located on an outer surface of the extension, wherein the plunger further includes a spring capable of biasing the plunger inwardly from an inner sleeve surface such that the at least one plunger aligns with and is partially contained within the at least one recess in order to position the sleeve relative to the extension. Because both the device of Keller as modified by Davidson and Myers teach devices comprising positioning mechanisms, it would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute one positioning mechanism for the other in order to achieve the predictable results of positioning the sleeve relative to the extension.

Further regarding claim 11, The device of Keller as modified by Davidson as further modified by Myers discloses a device wherein the sleeve is capable of being rotated about the longitudinal axis of the extension such that the at least one plunger aligns with and is at least partially contained within the at least one recess.

Response to Arguments

5. Applicant's arguments filed 09/08/2008 have been fully considered but they are not persuasive. The applicant's argument that the Keller reference and the Davidson reference are non-analogous art is not persuasive. The examiner would like to note that, "The examiner must determine what is "analogous prior art" for the purpose of analyzing the obviousness of the subject matter at issue. "Under the correct analysis, any need or problem known in the field of endeavor at the time of the invention and addressed by the patent [or application at issue] can provide a reason for combining the elements in the manner claimed." KSR International Co. v. Teleflex Inc., 550 U.S. ___, ___, 82 USPQ2d 1385, 1397 (2007). Thus a reference in a field different from that of applicant's endeavor may be reasonably pertinent if it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his or her invention as a whole." (See MPEP 2141.01(a)). When considered as a whole, both references are gripping devices that includes sleeve for opening and closing the gripping elements of the device. Therefore, the examiner believes that the references are analogous art and that the rejection under 35 U.S.C. 103(a) is proper. The applicant's argument that the Davidson reference does not teach rotating the sleeve to close the gripping elements is moot. The examiner is not using Davidson to teach the sleeve since the Keller reference already provides a sleeve. The examiner is using the Davidson reference to teach the bore of the sleeve having a width that is greater than a depth in a plane perpendicular to the longitudinal axis of the device, wherein the sleeve is capable of closing the gripping elements of the device when

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rotated. Keller discloses the sleeve of the device is rotated along a thread to close the gripping elements of the device by engaging a tapered portion of the bore with the gripping elements. By substituting the bore of the Keller sleeve with the bore of the Davidson sleeve, when the sleeve is rotated the engagement between the gripping elements and the inner surfaces defining the depth of the bore are capable of closing the gripping elements of the device. Therefore, the examiner believes that the device of Keller as modified by Davidson is capable of performing the functional limitations of the claims. The examiner recommends the applicant amend the claims to positively recite that the interaction between the inner surfaces of the bore and the gripping elements cause the gripping elements to close. The examiner has presented new grounds of rejection as necessitated by the amendment making this office action **FINAL**.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Woodall whose telephone number is (571)272-5204. The examiner can normally be reached on Monday to Friday 8:00 to 5:30 EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nicholas Woodall/

Examiner, Art Unit 3775

/Eduardo C. Robert/

Supervisory Patent Examiner, Art Unit 3733